

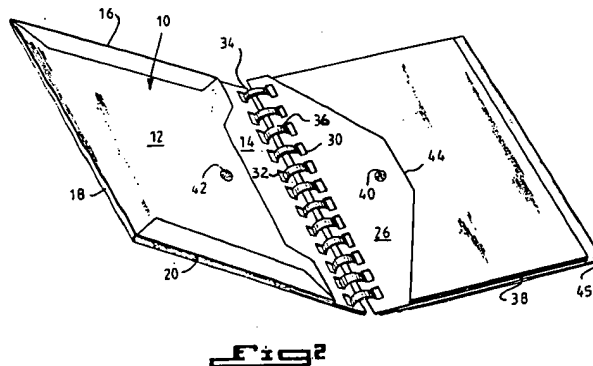
REMARKS

Applicant thanks Examiner Thurston for her attention to the above-referenced application in the Office Action of August 28, 2000 and respectfully request entry of the foregoing amendment and reconsideration of the application. To assist the Examiner, two sample pocket inserts are forwarded with the amendment.

Rejections Under 35 U.S.C. §102

Claims 1-4, 6-9, 11, 12, 19, 22 and 26-28 stand rejected under 35 U.S.C. §102 as being anticipated by Friedman (U.S. Patent No. 5,042,841). Examiner Thurston states each of the claim limitations is met by Friedman.

Examiner Thurston relies upon Friedman to disclose “a pocket insert comprising a base sheet (14), with a binding edge (32) bound to the binding, and a pocket sheet (12) with a smaller width, but at least 60 percent of the base sheet and the perimeter of which is defined by an attached edge (18) to the base sheet and a free section (24) to form a pocket opening extending substantially parallel and facing the binding (see figure 2).” [Paper 3, page 2]



However, applicant respectfully submits Friedman does not disclose the pocket sheet adhered to the base sheet. In Friedman, the base sheet and pocket sheet are not joined to each other, but to side walls 16, 18 and 20. (Col. 2, lines 44-46) That is, the base sheet is connected to walls 16, 18 and 20, and the side walls 16, 18 and 20 are connected to the pocket sheet. Thus, Friedman does disclose the perimeter of a pocket sheet defined by an attached section (at least a

portion of which is adhered to the base sheet) and a free edge section. There is no portion of the Friedman pocket sheet that is adhered to the base sheet.

Claim 1

As amended, Claim 1 recites in part,

a pocket sheet having *a perimeter defined by an attached edge section and a free edge section*, at least a portion of *the attached edge section being adhered to the base sheet* and the free edge section being unattached to the base sheet to form a pocket opening along the free edge section. [emphasis added]

As the Friedman pocket sheet (12) is connected to the side wall (18) and the remaining portion of the Friedman periphery is not attached to the base sheet (14) or the side walls (16, 20), Friedman does not disclose or suggest this limitation. Applicant respectfully submits the limitation of *at least a portion of the attached edge section being adhered to the base sheet* is not present in Friedman. The absence of at least this limitation precludes Friedman from sustaining a rejection under 35 U.S.C. §102.

There is no disclosure of the pocket sheet (12) adhered to the base sheet (14).

Specifically, Friedman states:

In erecting the cover 10, the cut blank is first folded along crease lines F1 *setting up wall 18* and overlying the panel 12 above panel 14. Thereafter, the lateral extensions and gussets 48 are folded about creases F2 and F3 *setting up the side walls 16 and 20 and the gussets 48 are inserted into the respective slits 52 placing the wing tabs 50 below the surface of the panel 12 to lock the gussets into place*. Thus, the pocket opening 22 is established. Thereafter, the entire assembly can be combined with the ring or spiral spine 36. [emphasis added] (Col. 3, lines 56-65)

Friedman does not attach the perimeter of the pocket sheet (12) to the base sheet (14). Friedman employs gussets (48) or flaps that extend from the base sheet and are folded about creases F2 and F3 to over lie the top surface of the pocket sheet. No portion of the perimeter of the Friedman pocket sheet 12 is not adhered to the base sheet.

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These distinctions further preclude Freidman from supporting a rejection under 35 U.S.C. §102. As Claims 2-4, 6-9, 11, 12 and 19 depend from Claim 1 and include all the limitations thereof, these claims also cannot be anticipated by Freidman.

Claim 22

As amended Claim 22 recites in part, “A pocket insert defined by a [generally rectangular] base sheet of paper material and a [generally rectangular] pocket sheet of paper material, the base sheet comprising:

a first edge, a second edge opposed to the first edge for binding to a binder, the first and second edges defining a width of the [first] base sheet, and third and fourth edges opposed to one another and disposed between the first and second edges, the third and fourth edges defining a length of the [first] base sheet;

the pocket sheet comprising:

a first edge attached to the base sheet, a second edge opposed to the first edge, the first and second edges defining a width of the pocket sheet, at least a portion of the second edge being unattached to the base sheet for forming a pocket opening, and third and fourth edges opposed to one another and disposed between the first and second edges, the third and fourth edges defining a length of the pocket sheet and being attached to the base sheet; wherein the second sheet has a shorter [width] length than the [first] base sheet and a width at least half the width of the base sheet.”

Claim 22 recites three edges (the first, the third and the forth) of the pocket sheet attached to the base sheet. As set forth in the discussion of Claim 1, the base sheet (14) of Friedman is attached to a side wall (18) and the pocket sheet (12) is attached to the side wall (18). Similarly, the portions of Friedman corresponding the claimed third and forth edges, are connected to side walls 16 and 20, respectively. That is, the pocket sheet of Friedman is not attached to the base sheet, but rather to the side walls 16, 18 and 20. The base sheet and the pocket sheet of Friedman are not connected to each other. Further, side walls 16 and 20 of Friedman are formed of the base sheet and neither these side walls nor the gussets are attached to the perimeter of the pocket sheet. Therefore, at least this limitation is absent from Friedman.

Claim 22, further recites the pocket sheet having a length (between the third edge and the forth edge) less than the base sheet. Applicant is unable to identify and corresponding structure in Friedman. Therefore, this limitation is not present in the cited reference.

As at least these limitations are not present in Friedman, applicant submits Friedman cannot sustain a rejection of Claim 22 under 35 U.S.C. §102.

Claim 26

Claim 26, recites in part, “A method of binding a book comprising:

(a) assembling in a stacked arrangement [multiple] a plurality of pages and a pocket insert, wherein the pocket insert comprises:

(b) a base sheet of paper material comprising a binding edge; and a pocket sheet of paper material, the perimeter of the pocket sheet [which is] defined by an attached edge section and a free edge section, *the attached edge section being attached to the base sheet* and the free edge section being unattached to the base sheet to form a pocket with a pocket opening along the free edge section; and

(c) binding the pages and the pocket insert, wherein the pocket insert is bound along its binding edge and the base and pocket sheets are arranged such that the pocket opens towards the binding.” [emphasis added]

Applicant respectfully submits, the structure of Friedman does not disclose or suggest a pocket sheet *attached* to a base sheet. The interconnecting side walls (16, 18 and 20) of Friedman create an additional thickness to the Friedman product, which is avoided with the present construction.

Therefore, applicant respectfully submits Claim 26 cannot be anticipated by Friedman. As Claims 27 and 28 depend from Claim 26 and include all the limitations thereof, these claims are also in condition for allowance.

Rejections Under 35 U.S.C. §103

Claims 5, 10, 13-18, 20, 21 and 23-25 stand rejected under 35 U.S.C. §103 as being unpatentable over Freidman (U.S. Patent No. 5,042,841) in view of Lippeth (U.S. Patent No. 6,024,508).

Examiner Thurston states Friedman does not disclose the base sheet and the pocket sheet formed of separate sheets of paper material adhered to one another along the attached edge section, and along another long strip parallel to the third and fourth edges to separate the pockets to form two sheets. [Paper 3, Page 3]

However, the examiner states it would have been obvious to form the base sheet and pocket sheet of separate sheets of paper material adhered to one another since it has been held constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

However, *Nerwin v. Erlichman*, decided in 1969 by the Patent Office Board of Patent Interferences, addressed the issue of demonstration by mere comparison that a patent claim and a count consisting of broaden modification of the patent claim recite distinct or different inventions is *not* determinative of the issue as to whether the patent claim and the count are directed to the same invention.

Further, Freidman expressly and repeatedly sets forth the use of side walls 16, 18 and 20 which thereby space the panel 12 from panel 14. Further, the interconnection of the panels is set forth by use of the gussets wherein “the gussets provide depth to the compartment equal to the size of the gussets.” [Col. 2, Lines 14-16]

To modify Freidman as proposed by Examiner Thurston would render Freidman inoperable for its intended use. That is, adhering a pocket sheet to the base sheet as set forth in the present claims would preclude gussets from being able to form the recited side walls (16, 18 and 20) of Friedman and provide a compartment depth equal to the size of the gussets as set forth

in Friedman. Therefore, applicant respectfully submits there has been no prima facie showing of obviousness to modify or in the modified structure of Freidman.

Lippeth is relied upon by the examiner to teach the use of a long strip parallel to third and fourth edges in order to create multiple pockets.

However, Lippeth does not cure the deficiencies of the primary reference. For example, a pocket sheet being shorter in width than the base sheet; the use of adhesives to join the edges.

Therefore, applicant respectfully submits Freidman and Lippeth cannot sustain rejection under 35 U.S.C. § 103 of these claims.

Newly added Claim

Newly added Claim 32, recites, in part, “ the base sheet and pocket sheet are arranged such that the pocket opening faces the binding and the pocket insert has a total thickness less than a combined thickness of the base sheet, the pocket sheet and one of the base sheet and the pocket sheet.”

In contrast, the Friedman structure has a thickness defined by the (i) the base sheet (14) plus (ii) the side walls (16 or 18 or 20) plus (iii) the pocket sheet (12) plus (iv) the gussets. This results in a structure of four layers. As the structure of Claim 32 recites a thickness less than three layers, Claim 32 is in condition for allowance.


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Therefore, applicant respectfully submits all the pending claims, Claims 1-32 are in condition for allowance and such action is earnestly solicited. If, however, the examiner feels that any further issues remain she is cordially invited to contact the undersigned so that such matters may be promptly resolved.

Respectfully submitted,



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Dated: November 28, 2000.